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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/502,082

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EXAMINER

STULII, VERA

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/502,082	<b>Applicant(s)</b> SIPS ET AL.	
	<b>Examiner</b> VERA STULII	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 16-18 and 21 is/are pending in the application.
- 4a) Of the above claim(s) 8-15, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 16-18 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/22/2004</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of invention of group I in the reply filed on April 8, 2008 is acknowledged. The traversal is on the ground(s) that "the burden of searching for all claims is not undue" (p. 2 of the response to requirement for restriction). This is not found persuasive because of the reasons of record as stated in the restriction requirement. Where the group of inventions is claimed in one and the same international application, the requirement for unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among the inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions considered as a whole, makes over the prior art. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT rule 13.1 because, under PCT Rule 13.2, although they share the special technical feature, this special technical feature does not define a contribution over the prior art for the following reasons: the technical feature linking the two inventions is that they both contain a stabilized starch n-alkenyl succinate. However, as evidenced by THE MISCELLANEOUS FOOD ADDITIVE REGULATIONS and Kettlitz et al (EP 0811633), a stabilized starch n-alkenyl succinate, is conventional and therefore does not provide a contribution over the prior art, so that there is no special technical feature and the restriction is appropriate.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7, 16-18 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-7, 16-18 and 21, the phrase "stabilized starch" renders the claim indefinite because it is unclear what the starch is being stabilized against.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-7, 16-18 and 21 are rejected under 35 U.S.C. 103(a) as being obvious over Kettlitz et al in view of Daenzer-Alloncle et al (6, 139, 896).**

In regard to claims 1 and 7, Kettlitz et al disclose heat stable high viscosity starches (Abstract). Further in this regard Kettlitz et al disclose that “the starches of the present invention are obtained by reacting high viscosity starch with activated chlorine under alkaline conditions” and “[t]he starches of the present invention are used to replace viscosity stable starches obtained by conventional chemical cross-bonding” (Col. 1 lines 3-8). Kettlitz et al disclose that high viscosity starches are starches which show an important increase in viscosity characteristics upon heating, starches with a high swelling power are those derived from waxy varieties and starches derived from tubers and roots (e.g. potato, tapioca) (Col. 1 lines 20-26). Kettlitz et al disclose that the swollen granules burst to a large extent during heating which leads again to a drastic viscosity breakdown. Kettlitz et al disclose that in order to overcome the undesirable viscosity breakdown starches may be stabilized (Col. 1 lines 20-26). The viscosity breakdown can be overcome by treating the starch granules with chemical reagents (Col. 1 lines 28-30). Kettlitz et al disclose that highly swollen (viscous) cooking stable

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starches are used in many different applications, for example in the preparation of soups, sauces, meat products, dressings, micro-wavable food and in the preparation of bakery creams and fillings, in convenience foods that need to have a high viscosity and smooth texture after heating (to 80-100°C) (Col. 1 lines 46-50). Kettlitz et al disclose that stabilized high viscosity starches are particularly suitable for the mentioned applications (Col. 1 lines 51-53).

In regard to claims 1-7, 16-18 and 21, Kettlitz et al disclose stabilized starch n-alkenyl succinate (Col. 2 lines 55-56).

In regard to claims 3 and 16, Kettlitz et al disclose stabilized starch n-octenyl succinate (Col. 2 lines 56-57).

In regard to claims 4 and 5, Kettlitz et al disclose that all starches can be used to prepare the stabilized starch n-octenyl succinate (Col. 3 lines 46-48).

In regard to claims 6 and 7, Kettlitz et al disclose soups, sauces, meat products, dressings, micro-wavable food, bakery creams and fillings (Col. 1 lines 46-50).

Kettlitz et al do not specifically disclose UHT treatment of the food products. However, Kettlitz et al disclose use of stabilized starch n-alkenyl succinate in the food products that normally undergo UHT/high-temperature/sterilization/ pasteurization treatment.

In regard to claims 1, 7, 17 and 18, Daenzer-Alloncle et al disclose a lactic cream which has been treated by an ultra-high temperature ("UHT") treatment or other sterilization procedure or by pasteurization to provide a cream product for unrefrigerated storage and which contains between 1.5 and 4% by weight of modified starch for

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controlling viscosity, so that the composition has a viscosity between 250 and 1600 mPas (Abstract).

Since Daenzer-Alloncle et al disclose use of modified starch as a viscosity component in a cream product that undergoes heat treatment, and Kettlitz et al disclose use of heat stable high viscosity starches in preparation of cream products, one of ordinary skill in the art would have been motivated to employ heat stable high viscosity starches in preparation of cream products as taught by Daenzer-Alloncle et al. One of ordinary skill in the art would have been motivated to do so, since both Kettlitz et al and Daenzer-Alloncle et al. disclose use of modified starch as a viscosity component; foods that undergo UHT/high-temperature/sterilization/ pasteurization treatment; and the importance of heat stability of starches.

Regarding particular viscosity recitations after re-heating in claims 1, 2, 5, 7 and 21, it is noted that although the references do not specifically disclose every possible quantification or characteristic of its product, such as viscosity after re-heating, this characteristic would have been expected to be in the claimed range absent any clear and convincing evidence and/or arguments to the contrary. The combination of references disclose the same starting materials and methods as instantly (both broadly and more specifically) claimed, and thus one of the ordinary skill in the art would recognize that the viscosity after re-heating, among many other characteristics of the product obtained by referenced method, would have been an inherent result of the process disclosed therein. The Patent Office does not possess the facilities to make and test the referenced method and product obtain by such method, and as reasonable

reading of the teachings of the references has been applied to establish the case of obviousness, the burden thus shifts to applicant to demonstrate otherwise.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERA STULII whose telephone number is (571)272-3221. The examiner can normally be reached on 7:00 am-3:30 pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VS

/KEITH D. HENDRICKS/  
Supervisory Patent Examiner, Art Unit 1794